



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/745,471	12/26/2000	Minoru Fukuda	201273US2	1853

7590 08/13/2003

Oblon Spivak McClelland Maier & Neustadt
Fourth Floor
1755 Jefferson Davis Highway
Arlington, VA 22202

EXAMINER

FOX, CHARLES A

ART UNIT

PAPER NUMBER

3652

DATE MAILED: 08/13/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/745,471

Applicant(s)

FUKUDA, MINORU

Examiner

Charles A. Fox

Art Unit

3652

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 May 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-134 is/are pending in the application.
- 4a) Of the above claim(s) See Continuation Sheet is/are withdrawn from consideration.
- 5) ☒ Claim(s) See Continuation Sheet is/are allowed.
- 6) ☒ Claim(s) 34, 62, 101, 128 and 129 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 April 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Continuation of Disposition of Claims: Claims withdrawn from consideration are 4-11,18,20,23,24,26,28,30-32,35-38,40,44-50,53,56,57,61,63,65,71-78,85,87,90,91,93,95,97,98,102-105,107,111-117,120,121,123,124,130 and 132.

Continuation of Disposition of Claims: Claims allowed are 1-3,12-17,19,21,22,25,27,29,33,39,41-43,51,52,54,55,58-60,62,64,66-70,79-84,86,88,89,92,94,96,99,100,106,108-110,118,119,122,125-127,131,133 and 134.

Claim Rejections - 35 USC § 112 First Paragraph

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 34,62,101 and 129 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The intersection restricting means (25) set forth in claims 34,62,101,129 does not form a roll up space for the discharged sheet, but rather is used as a stop for the actual roll up device. See the specification page 12 lines 5-12. Since this limitation is all that sets the group of claims apart from other claims they have not been treated on the merits. Claims 36 and 103 which depend from claims 34 and 101 are withdrawn from consideration at this time as the scope of the claims is indeterminate at this time.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 128 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kando in view of Kramer. In regards to claim 128 Kando US 4,720,728 teaches a sheet conveying device comprising:

straight storing means (5) protruding to the rear of said device for storing sheets driven out of said device by discharging means (R6,R7);

a path diverter (6) for diverting a sheet from said straight storing means along a curved path to a second storage area;

wherein said diverter is selectively operable to divert said sheets when in place, or to allow sheets to pass to the straight storage means.

Kando does not teach the diverter as being a roll up device or that it pivots about a shaft. Kramer et al. teach a sheet conveying device comprising:

a roll up storage (102) configured to roll up a sheet being discharged from said sheet conveying device (72,74), and storing said sheet in a roll;

a spacing member (100) serves as a connecting means for displaceably connecting said roll up means to said sheet conveying device;

wherein said displacement is of said roll up storage (102) pivoting about a shaft;

wherein said sheet conveying device discharges said sheet to outside of said image reading device;

wherein said roll up device is movable between a position for rolling up said sheet and a position for allowing a person to pick up said sheet at an operating position;

wherein said sheet is picked up from said roll up storage (102) with the trailing edge of the sheet spaced from said body;

Art Unit: 3652

wherein said image surface is positioned on the inside of the rolled sheet.

It would have been obvious to one of ordinary skill in the art, at the time of invention to provide the roll up storage taught by Kramer et al. on the device taught by Kando in order to allow an operator of the device to either roll up a sheet discharged from said device or discharge it to a receiver such that it is flat.

Response to Amendment

The amendments to the claims filed on May 27, 2003 have been entered into the record.

Allowable Subject Matter

Claims 1-3,12-17,19,21,22,25,27,29,33,39,41-43,51,52,54,55,58-60,62,64,66-70,79-84,86,88,89,92,94,96,99,100,106,108-110,118,119,122,125-127,131,133,134 are allowed. The limitation of the rolling up means cooperating with the straight storage means is not taught or suggested in any of the cited prior art.

Response to Arguments

Applicant's arguments filed May 27, 2003 have been fully considered but they are not persuasive. In regards to the 35 U.S.C. §112 rejections of claims 34,62,101 and 129, the claim clearly states that the intersection restricting means (25) forms a roll up space for the sheet. This is not supported in the specification at any place as asserted by the applicant. The intersection restricting mean forms a stop to properly position the roll up storage means to receive a sheet of paper. Therefore the rejection is valid and will not be withdrawn.

In regards to claim 128, not direct arguments were presented supporting this claim. Broad arguments against the references cited were presented with the assertion that all independent claims had the limitation cited above as being the allowable feature of the instant invention. Claim 128 does not include this limitation, therefore the previous rejection is still valid.

Conclusion

Claims 1-3,12-17,19,21,22,25,27,29,33,39,41-43,51,52,54,55,58-60,62,64,66-70,79-84,86,88,89,92,94,96,99,100,106,108-110,118,119,122,125-127,131,133,134 are in condition for allowance.

Claims 34,62,101, 128 and 129 are rejected

Claims 4-11,18,20,23,24,26,28,30-32,35-38,40,44-50,53,56,57,61,63,65,71-78,85,87,90,91,93,95,97,98,102-105,107,111-117,120,121,123,124,130 and 132 are withdrawn from consideration.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of


Art Unit: 3652

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles A. Fox whose telephone number is 703-605-4294. The examiner can normally be reached between 7:00-5:00 Monday, Tuesday, Thursday and Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eileen D. Lillis can be reached at 703-308-3248. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9306 for regular communications and 703-872-9306 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.


EILEEN D. LILLIS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600

CAF
August 11, 2003

CAF 8-11-03